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In the Drawings:

The attached drawing sheet includes changes to Fig. 3. The replacement sheet, which includes Fig. 3, replaces the original sheet including Fig. 3. Changes to Fig. 3 include the revision of the hidden lines of reference numbers 12, 32, 34, 36, and 38 to solid lines.

Attachments: Replacement Sheet of Fig. 3

Annotated Sheet Showing Changes Made to Fig. 3

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REMARKS

Claims 1-6 remain present in this application and claims 7-8 have been withdrawn. By way of this Amendment, Fig. 3 and claim 4 have been amended. Applicant respectfully requests reconsideration and allowance of the present application.

Applicant wishes to thank Examiner Wujciak for the courtesies extended to Applicant's attorney, Matthew Gipson, during a telephonic interview conducted on August 7, 2006. During the interview, an agreement was reached in which Applicant's attorney elected the claims in Group I, which included claims 1-6, and non-elected the claims in Group II, which included claims 7-8, without traverse.

In the present non-final Office Action, the Examiner objected to the drawings because reference numbers 12, 32, 34, 36, and 38 show hidden lines (Fig. 3), which are in error because they are not designed to be hidden. Applicant has amended Fig. 3, as requested by the Examiner. Applicant respectfully submits that, with this correction, the drawings are in condition for acceptance. Therefore, Applicant respectfully requests that the objection to the drawings be withdrawn.

In the present Office Action, the Examiner rejected claims 1, 3-4, and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,573,227 issued to Hemauer et al. (hereinafter "Hemauer et al."); and rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer et al., in view of U.S. Patent 5,314,167 issued to Holloman (hereinafter "Holloman"). Applicant respectfully traverses these rejections for the reasons presented below.

Before discussing the rejected claims and the applied references, it is important to appreciate Applicant's claimed invention and the advantages realized therefrom. The invention provides for a fascia guard bracket comprising a first generally U-shaped recess for receiving the fascia board of a roof between trusses, a fastening member for securing the first generally U-shaped recess to the fascia board, and a second generally

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U-shaped recess for receiving a guard board. The fascia guard bracket is not designed to be attached to a roof truss.

In regard to the rejection of claims 1, 3-4, and 6 under 35 U.S.C. § 102(b) as being anticipated by Hemauer et al., Applicant respectfully submits that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (emphasis added). Furthermore, functional language in an apparatus claim requires that the anticipatory reference possess the capability of performing the recited function. *R.A.C.C. Industries Inc. v. Stun-Tech Inc.*, 49 U.S.P.Q.2d 1793 (Fed. Cir. 1998) ("[I]n *Intel Corp. v. U.S. International Trade Commission*, 948 [sic, 946] F.2d 821, 832; 20 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1991), this court interpreted functional language in an apparatus claim as requiring that an accused apparatus possess the capability of performing the recited function.").

At the outset, Applicant notes that Hemauer et al. is directed to a stanchion, which has a bracket part that is attached to both the fascia board and a rafter. Hemauer et al. is different from the present claimed invention in that the device must be mounted at the fascia board where the rafter truss is located. The Hemauer et al. device is attached to the fascia board by nailing through a "facia nailing flange," and not a U-shaped recess. The rafter support arms of the Hemauer et al. device are designed to attach to the rafter. In contrast, the present claimed invention is attached to the fascia board of a roof between trusses, utilizing a U-shaped recess and a fastening member. While this limitation is currently present in claim 1, the limitation has been added to claim 4. Hemauer et al. also does not teach a fastening member of a bolt.

In regard to the rejection of claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer et al., in view of Holloman, Applicant respectfully submits that the combined references fail to teach or suggest each and every limitation of the

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rejected claims. In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 783 F.2d 1038, 1041; 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986).

Holloman discloses a rail structure for a floor, not a roof. Indeed, the Holloman structure cannot realistically be used on a pitched roof due to the shape of the device. In addition, the attaching means 14 of the Holloman device is not adapted to be utilized with a roof. In order for the device to be attached, the inside leg 16 of the attachment means 14 must be inserted through an opening 40 in the sub-floor. *See col. 4, ll. 4-8.* The Holloman device has absolutely no bearing on roofs, because that structure cannot be used with roofs due to the fact that a hole would need to be placed into the roof, and the fact that the device is not configured to be utilized with a pitched floor, let alone a pitched roof.

Because the references alone, or in combination, fail to teach or suggest each and every limitation of claims 2 and 5, the rejection of claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer et al., in view of Holloman, is improper and should be withdrawn, which action is respectfully requested.

By way of the foregoing discussion, Applicant has demonstrated that the pending claims are not anticipated by Hemauer et al., and would not have been rendered

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obvious in view of Hemauer et al., in combination with Holloman. Accordingly, the rejections of claims 1-6 under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn, which action is respectfully solicited.

Applicant respectfully submits that this Amendment and Reply are fully responsive to the above-referenced Office Action, and that the claims are in condition for allowance, such allowance being respectfully requested.

CONCLUSION

If the Examiner has any questions or comments with respect to this Amendment and Reply, the Examiner is encouraged to contact the undersigned at 616/949-9610.

Respectfully submitted,

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Date

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